The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL D. ZOECKLER

Appeal No. 2006-0532
Application No. 09/559,704

ON BRIEF

Before FRANKFORT, McQUADE, and BAHR, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

REMAND TO THE EXAMINER

The above identified application is being remanded to the examiner under the authority of 37 CFR § 41.50(a)(1) for appropriate action with regard to the items listed below.

In light of this remand, the oral hearing scheduled for 1:00 PM on March 21, 2006 has been vacated.

Claims 1 through 7, 9 through 16 and 25 through 34 are pending in the application and on appeal. Claims 8, 17 through

24 and 35 through 39 have been canceled. An examiner's answer maintaining various rejections of the claims on appeal under 35 U.S.C. § 102(b) and/or 35 U.S.C. § 103(a) was mailed on February 24, 2005.

On April 25, 2005 appellant filed a reply brief. In response to the reply brief, the examiner sent out a notice (May 26, 2005) informing appellant that the reply brief had been "received along with a request for oral hearing." Our problem is that the examiner has not provided any indication as to whether or not the reply brief was entered and considered. Thus, we REMAND the application to the examiner to indicate on the record whether the reply brief has been properly entered and considered, and also for a response on the record to the particular arguments raised by appellants in the reply brief concerning both the Stone and Lang references.

As a second point of concern, we note the use in the answer of the patent to Campbell (US 1,600,396) along with Lang (US 5,147,480) to support the rejection of claims 1, 3 through 5, 7, 9 through 11, 16, 25, 29 through 32 and 34 under 35 U.S.C.

§ 103(a). Previously, in the non-final action mailed August 25, 2004, and from which appellant has appealed, Lang was used alone to reject the recited claims, with the examiner taking "Official Notice" that at the time the invention was made "it would have been obvious to a person of ordinary skill in the art to use the method of Lang on non-corrugated paperboard." Thus, the above-noted patent to Campbell was used for the first time in the answer to support a rejection which is clearly different from that which was appealed from by appellant.

This point was brought to the examiner's attention in an "Order Returning Undocketed Appeal To Examiner" mailed September 28, 2005. That Order characterized the rejection as a new ground of rejection, pointed out the need for approval of such a new ground of rejection by a Technology Center Director or designee, and returned the application to the examiner to vacate the answer mailed February 24, 2005. The examiner's response mailed October 31, 2005 concedes that the patent to Campbell "is relied upon for evidence in the rejection now set forth," and to meet what the examiner recognizes as a "substantial evidence test." The examiner contends however that since this reference was cited in response to a challenge from appellant to the earlier use of

"Official Notice" (brief, pages 17-19), its use in the answer does not amount to a new ground of rejection. Thus, the examiner returned the application to the Board without further change.

We agree that in certain limited circumstances the examiner may take "Official Notice" of facts not in the record and rely upon such information to fill in a gap which might exist in the evidentiary showing necessary to support a rejection. However, the notorious character of such noticed facts must be capable of instant and unquestioned demonstration as being well known. In the present case, the examiner did not take Official Notice of a fact, but instead appears to have taken notice of the conclusion that "it would have been obvious to a person of ordinary skill in the art to use the method of Lang on non-corrugated paperboard." The examiner provided no technical or scientific line of reasoning to support this conclusory statement.

In the brief (pages 17-19), appellant asserted that the examiner's use of "Official Notice" in this particular case was improper and based solely on supposition. We agree, noting particularly that assertions of technical fact in an area of esoteric technology like the paperboard carton making art

involved in the present case or of specific knowledge of the prior art of the nature relied upon by the examiner in this case must always be supported by citation of some form of prior art.

For the above reasons, we consider the examiner's use of "Official Notice" to have been clearly improper and consider that use of the patent to Campbell (US 1,600,396) along with Lang (US 5,147,480) for the first time in the answer to support the rejection of claims 1, 3 through 5, 7, 9 through 11, 16, 25, 29 through 32 and 34 under 35 U.S.C. § 103(a) constitutes a NEW GROUND of rejection. Thus, we remand for the examiner to follow the guidance provided in the previously mailed Board Order of September 28, 2005.

Moreover, we also note the examiner's reference in the answer (page 8) to what are apparently three additional patents used to support the examiner's conclusory statement in the Office action mailed August 25, 2004. As pointed out by the Court in In re Hoch, 428 F.2d 1341, 1342, 166 USPQ 406, 407 (CCPA 1970), where a reference is relied upon to support a rejection, whether or not in a minor capacity, there would appear to be no excuse

for not positively including the reference in the statement of the rejection.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (item D), Eighth Edition, Rev. 3, August 2005.

REMAND TO THE EXAMINER

CHARLES E. FRANKFORT
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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